



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,458	10/11/2001	Gordon T. Brown	47781-6	9828

7590 04/27/2004

Alan G. Towner
Pietragallo, Bosick & Gordon
One Oxford Centre, 38th Floor
301 Grant Street
Pittsburgh, PA 15219

EXAMINER

CHARLES, DEBRA F

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,458

Applicant(s)

BROWN, GORDON T.

Examiner

Debra F. Charles

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 13.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

1. Claims 1-27 have been cancelled and claims 28, 59, and 63 have been amended.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 28-70 are rejected under 35 U.S.C. 101 because the bodies of the claims do not recite technology, i.e. computer implementation or any other technology in a non-trivial manner. *In re Toma*, 197 USPQ 852 (CCPA 1978). *Ex parte Bowman* 61 USPQ2D 1669.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) The claimed invention must produce a “useful, concrete, tangible result” (*In re Alappat*, 31USPQ2d 1545, 1558 (Fed. Cir. 1994) and *State Street vs. Financial Signature Group Inc.*, 47 USPQ2d 1596’ 1601-02 (Fed Cir. 1998));

AND

2) The claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. Pat. App. & Inter. 2001)).

As to the technology requirement, note MPEP 2106 IV B 2(b). Also note *In re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches “useful arts” is synonymous with “technological arts”. In *Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

In *State Street*, “in the technological arts” was never an issue. The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman* 61USPQ2d 1665,1671 (BD. Pat. App. & Inter.2001)(Unpublished).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 28,32,39,40, 51,55, and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Barry E. Cushing and Marshall B. Romney, Accounting Information Systems: A Comprehensive Approach, 5th ed. 1990(hereinafter referred to as Cushing et al).

Re claims 28, 51, 55 and 59: Cushing et al. disclose a method, computer readable medium and apparatus of providing financial accounting statements for a first entity(page 6, i.e. under the heading The Role of the Accounting Information System), comprising:

↪

Art Unit: 3628

providing transaction codes, including standardized codes(page 13, i.e. classifying data which involves assigning identification codes (account number, department number, etc.) to data records based on a predetermined system, such as a chart of accounts, page 74-83, i.e. coding techniques);

the first entity conducting with a plurality of other entities separate financial transactions(page 20, i.e. a typical business entity will engage in a large volume of transactions, which may be greatly varied.);

associating at least one of the transaction codes at about the time when funds are transferred or instructions are given for transfer to complete each financial transaction(Pages 62-63, i.e. transaction data captured in machine-readable form at their time and place of origin. And transactions may be classified into four general types, Fig. 3.1, page 65, Fig. 3.3, i.e. transaction file has account number associated with the transaction, page 77-83, i.e. block coding is usually applied to the major account codes and often to the divisional and departmental codes as well);

transmitting a record of each transaction and the at least one transaction code via a network to at least one file(page 13, i.e. transmitting data from one location to another, Fig. 7.22, i.e. with EDI); and

sorting the transactions in the at least one file and producing an accounting statement including income, expense, asset or liability information for the first entity(page 13, i.e. sorting data, which involves arranging a batch of input records into some desired numerical or alphabetical sequence, and pages 22-23, i.e. preparation of financial information).

Re Claim 32: Cushing et al. disclose the standardized codes comprise financial transaction codes(page 13, i.e. classifying data which involves assigning identification codes (account number, department number, etc.) to data records based on a predetermined system, such as a chart of accounts).

Re Claim 39: Cushing et al. disclose providing a subsidiary ledger for each of said other entities(page 20, under Purchasing of Assets and Services, the ledgers inventory, fixed asset, expenses and accounts payable are all subsidiary ledgers, page 24, detailed ledgers are subsidiary ledgers); and

transferring selected subsidiary ledgers from said other entities to said file(page 13, i.e. transmitting data from one location to another, Fig. 7.22, i.e. with EDI).

Art Unit: 3628

Re Claim 40: Cushing et al. disclose providing access to said subsidiary ledger for said first entity and/or agents of said first entity, whereby said first entity and/or agent can perform one or more activities selected from the group consisting of entering, deleting, reviewing, adjusting and processing said data inputs in said selected subsidiary ledgers(page 13-14, under the data preparation stage and the following paragraphs, lists various data processing functions).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 29, 30, 31, 33, 34, 35, 36, 37, 41, 42, 43, 44, 45,47, 52,53,54, 56, 57, 58, 60, 61, 62, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing et al. and Braun et al.(U.S.PAT. 4321672A).

Cushing et al. disclose(s) the claimed invention except the separate financial transactions include the transfer of funds and the instructions for transfer of funds; at least one transaction code is selected by the first entity; at least one transaction code is selected by at least one of the other entities; the transmission of the record of each transaction and at least one transaction code is initiated at about the time when funds are transferred or instructions are given for the transfer of funds; the transaction codes are provided from a menu; entering into said file information regarding said first entity; said information includes beginning balances for income, expenses, assets, liabilities and/or bank accounts; entering into said file coding information appropriate to said first entity; providing a funds transfer facility to facilitate transfer of funds to and from said first entity and said other entities; and employing said funds transfer facility to receive an instruction to transfer funds; transferring funds from said first entity to said other entities based on said instruction; employing said funds transfer facility to transmit data related to said transfer of funds; and employing said funds transfer facility to adjust current records; and a first computer having at least one file from which an accounting statement may be generated; a second computer for receiving data inputs, said data inputs including electronically recorded financial transactions made between said first entity and a second entity; a communication network for transferring said data inputs from said second computer to said file of said first computer.

However, in Abstract, Fig. 4, col. 2, lines 25-67, col. 3, lines 25-67, col. 4, lines 35-60 thereof, Braun et al. disclose(s) electronic funds transfer from a plurality of terminals

Art Unit: 3628

with wire instructions(authorization message and reference number); transaction codes selected by various entities, and transmitting a record of the transaction(parallel documented audit trail); and the transaction codes are provided from a menu in Fig. 4; in addition to transfers of data, funds and financial statements from one entity to another entity.

It would be obvious to one of ordinary skill in the art to modify the invention of Cushing et al. based on the teachings of Braun et al. The motivation to combine these Cushing et al. and Braun et al. references is to electronically send funds from one point to another so that the transaction can be performed efficiently in the financial institution. It should be noted that sending electronic funds with instructions is old and well-known in the automated clearing house art. It would be obvious to send instructions to identify the source of funds, bank, and what the funds represent(interest on a bond, dividends on a stock, etc.).

7. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing et al. and Sloan et al.(U.S.PAT. 5146067A).

Cushing et al. disclose(s) the claimed invention except said first entity and/or agents of said entity a passcode to permit access to said file. However, in the Abstract, col. 7, lines 55-col. 8, line 67, col. 9, lines 30-50, col. 10, lines 30-60,col. 18, lines 1-25,col. 19, lines 15-40 thereof, Sloan et al. disclose(s) password access to computer files. It would be obvious to one of ordinary skill in the art to modify the invention of Cushing et al.

based on the teachings of Sloan et al. The motivation to combine these Cushing et al. and Sloan et al. references is to enhance the security of the accounting computer system by limiting access to authorized individuals.

8. Claims 46,48,49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing et al. and Braun et al. as applied to claim 45 above, and further in view of Marks (U.S. PAT. 5117356A).

Re Claims 46,49, and 50: Cushing et al. and Braun et al. disclose(s) the claimed invention except a first said file in said first computer for receiving accrual accounting data inputs; and a second said file in said first computer for receiving cash accounting data inputs; And first and second computer is a personal computer. However, in the Abstract, Figs. 1, item 14, col. 2, lines 45-60, col. 3, lines 55-67, col. 13, lines 20-50 thereof, Marks disclose(s) computers receiving cash and accrual based accounting data from a PC. It would be obvious to one of ordinary skill in the art to modify the invention of Cushing et al. and Braun et al. based on the teachings of Marks. The motivation to combine these references is enhancing the system of Cushing et al. and Braun et al. to reflect cash and accrual accounting techniques automated using a PC.

Re Claim 48: Cushing et al. disclose said second computer comprises means for electronically recording, collecting, processing, storing and transmitting said financial

transactions(page 13-14, under the data preparation stage and the following paragraphs, lists various data processing functions).

9. Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing et al. as and Matsushita et al.(U.S. PAT. 4837556A).

Cushing et al. disclose(s) the claimed invention as per claims 28,32,39,40, 51,55, and 59 as above except data signal embodied in a carrier wave. However, in col. 21, lines 5-25 and col. 22, lines 1-45 thereof, Matsushita et al. discloses a signal transmission device using carrier waves which is well known in the art. It would be obvious to one of ordinary skill in the art to modify the invention of Cushing et al. based on the teachings of Matsushita et al. The motivation to combine these references is to provide a means for data transmission that effectively transfers into computer technology.

10. Claims 64,65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing et al. and Matsushita et al. as applied to claim 63 above, and further in view of Braun et al.

Cushing et al. and Matsushita et al. disclose(s) the claimed invention except wherein the separate financial transactions include the transfer of funds and the instructions for

transfer of funds; at least one transaction code is selected by the first entity; and wherein the standardized codes comprise financial transaction codes.

However, in Abstract, Fig. 4, col. 2, lines 25-67, col. 3, lines 25-67, col. 4, lines 35-60 thereof, Braun et al. disclose(s) electronic funds transfer from a plurality of terminals with wire instructions(authorization message and reference number); transaction codes selected by various entities, and transmitting a record of the transaction(parallel documented audit trail); and the transaction codes are provided from a menu in Fig. 4; in addition to transfers of data, funds and financial statements from one entity to another entity. It would be obvious to one of ordinary skill in the art to modify the invention of Cushing et al. and Matsushita et al. based on the teachings of Braun et al. The motivation to combine these Cushing et al., Matsushita et al. and Braun et al. references is to electronically send funds from one point to another so that the transaction can be performed efficiently in the financial institution. It should be noted that sending electronic funds with instructions is old and well-known in the automated clearing house art. It would be obvious to send instructions to identify the source of funds, bank, and what the funds represent(interest on a bond, dividends on a stock, etc.).

11. Claim 67, 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing et al. and Braun et al.

Cushing et al. disclose(s) the claimed invention except providing a second computer for receiving data inputs, said data inputs including electronically recorded financial transactions made between said first entity and a second entity; And further including transferring funds from said first entity to said second entity.

However, in Abstract, Fig. 4, col. 2, lines 25-67, col. 3, lines 25-67, col. 4, lines 35-60 thereof, Braun et al. disclose(s) electronic funds transfer from a plurality of terminals(first and second entities) with wire instructions(authorization message and reference number); transaction codes selected by various entities, and transmitting a record of the transaction(parallel documented audit trail); and the transaction codes are provided from a menu in Fig. 4; in addition to transfers of data, funds and financial statements from one entity to another entity.

It would be obvious to one of ordinary skill in the art to modify the invention of Cushing et al. based on the teachings of Braun et al. The motivation to combine these Cushing et al. and Braun et al. references is to electronically send funds from one point to another so that the transaction can be performed efficiently in the financial institution. It should be noted that sending electronic funds with instructions is old and well-known in the automated clearing house art. It would be obvious to send instructions to identify the source of funds, bank, and what the funds represent(interest on a bond, dividends on a stock, etc.).

12. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing et al., Matsushita et al. and Braun et al.

Cushing et al. disclose(s) the claimed invention as per claims 28,32,39,40, 51,55, and 59 as above except data signal embodied in a carrier wave. However, in col. 21, lines 5-25 and col. 22, lines 1-45 thereof, Matsushita et al. discloses a signal transmission device using carrier waves which is well known in the art. It would be obvious to one of ordinary skill in the art to modify the invention of Cushing et al. based on the teachings of Matsushita et al. The motivation to combine these references is to provide a means for data transmission that effectively transfers into computer technology.

Cushing et al. and Matsushita et al. disclose(s) the claimed invention except providing a second computer for receiving data inputs, said data inputs including electronically recorded financial transactions made between said first entity and a second entity; And further including transferring funds from said first entity to said second entity.

However, in Abstract, Fig. 4, col. 2, lines 25-67, col. 3, lines 25-67, col. 4, lines 35-60 thereof, Braun et al. disclose(s) electronic funds transfer from a plurality of terminals(first and second entities) with wire instructions(authorization message and reference number); transaction codes selected by various entities, and transmitting a

Art Unit: 3628

record of the transaction(parallel documented audit trail); and the transaction codes are provided from a menu in Fig. 4; in addition to transfers of data, funds and financial statements from one entity to another entity.


It would be obvious to one of ordinary skill in the art to modify the invention of Cushing et al. and Matsushita et al. based on the teachings of Braun et al. The motivation to combine these Cushing et al., Matsushita et al. and Braun et al. references is to electronically send funds from one point to another so that the transaction can be performed efficiently in the financial institution. It should be noted that sending electronic funds with instructions is old and well-known in the automated clearing house art. It would be obvious to send instructions to identify the source of funds, bank, and what the funds represent(interest on a bond, dividends on a stock, etc.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

Art Unit: 3628

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantzy Poinvil can be reached on (703) 305-9779. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


FRANTZY POINVIL
PRIMARY EXAMINER

Art 3628

Debra F. Charles

Examiner

Art Unit 3628
